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EXAMINER
LOUIS, LATOYA M

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GARY N. HOLDER

Appeal 2015-003873[1]
Application 12/105,309[2]
Technology Center 3700

Before PHILIP J. HOFFMANN, JAMES L. WORTH, and KENNETH G. SCHOPFER, *Administrative Patent Judges*.

HOFFMANN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the rejection of claims 6–13. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

According to Appellant, the invention is directed "to a gas conserving device that utilizes an electronically controlled latching valve to regulate the

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[1] Our decision references Appellant's Specification ("Spec.," filed June 19, 2008), Appeal Brief ("Appeal Br.," filed Sept. 29, 2014), and Reply Brief ("Reply Br.," filed Feb. 3, 2015), as well as the Examiner's Answer ("Answer," mailed Dec. 4, 2014).

[2] Appellant indicates that "[t]he real party in interest is RIC Investments, LLC, . . . which is a subsidiary of Koninklijke Philips Electronics N.V." Appeal Br. 2.

flow of gas to a user." Spec. ¶ 2. Claims 6, 8, 10, and 12 are the only independent claims. *See* Appeal Br. We reproduce claim 6, below, as representative of the appealed claims.

> 6. A gas conserving device comprising:
>
> a gas flow switch having a plurality of selectable settings, wherein a different quantity of gas to is delivered to a patient by the gas conserving device for each setting in the plurality of selectable settings;
>
> a valve housing adapted to be disposed between a gas source and a patient, wherein the valve housing includes a valve body and a valve seat disposed in the valve body;
>
> a valve element disposed within the valve body, wherein a portion of the valve element is adapted to seat against the valve seat responsive to the valve element being in a closed position, and wherein the portion of the valve element is spaced apart from the seat responsive to the valve element being in an open position;
>
> a resilient member configured to bias the valve element toward the closed position; and
>
> a permanent magnet configured to magnetically attract the valve element toward the open position, and hold the valve element in the open position without electrical energy or residual magnetism caused by the electrical energy,
>
> wherein, with the valve in the closed position, the bias provided by the resilient member is stronger than the magnetic attraction between the permanent magnet and the valve element to maintain the valve element in the closed position, and with the valve in the open position magnetic attraction between the permanent magnet and the valve element is stronger than the bias provided by the resilient member to the valve element to hold the valve element in the open position; and
>
> an electrical energy source adapted to move the valve element between the closed position and the open position, wherein the energy source provides substantially a same amount

> of energy to move the valve element independent of the setting of the gas flow switch.

Id.

REJECTIONS AND PRIOR ART

The Examiner rejects the claims as follows:

I. claims 6–9 under 35 U.S.C. § 103(a) as unpatentable over Phillips (US 5,928,189, iss. July 27, 1999) and Heinonen (US 6,148,816, iss. Nov. 21, 2000);

II. claims 10–13 under 35 U.S.C. § 103(a) as unpatentable over Phillips, Heinonen, Reinicke (US 4,482,346, iss. Nov. 13, 1984), and Bliss (US 6,484, 721 B1, iss. Nov. 26, 2002);[3] and

III. claims 12 and 13 under 35 U.S.C. § 103(a) as unpatentable over Phillips, Heinonen, Bliss, and Moldenhauer (US 5,180,138, iss. Jan. 19, 1993).

Final Action 2–9; *see also* Answer 2–10.

ANALYSIS

Independent claim 6 recites, among other limitations, "a permanent magnet configured to magnetically attract the valve element toward the open position, and hold the valve element in the open position without electrical energy or residual magnetism caused by the electrical energy." Appeal Br., Claims App. We agree with Appellant that the Examiner fails to establish

[3] Although the Final Office Action and the Answer reference the rejection of claim 14, this appears to be a typographical error as claim 14 is not pending. *See* Final Action 4; *see also* Answer 4; *see also* Appeal Br., Claims App.

that any reference discloses this limitation. *See* Appeal Br. 7–11; *see also* Reply Br. 2–4.

The Examiner does not find that Phillips discloses a magnet (permanent or otherwise) that holds a valve element in an open position without electrical energy or residual magnetism caused by electrical energy. Rather, the Examiner finds that Phillips discloses "a magnetic stainless steel element . . . configured to magnetically attract the valve element toward the open position." *See. e.g.*, Answer 3. While it is unclear from the Examiner's determination, it appears that, in fact, Phillips may require power to maintain the valve in the open position. *See id.* ("col. 2[,] lines 10[–]14, [and] col. 6[,] li[n]es 58[–]63 [of Phillips] disclose that the valve is moved to the open position using a small amount of power and remains in the open position without requiring additional power.").

Instead, the Examiner relies on Heinonen to disclose the claimed permanent magnet. Specifically, the Examiner determines that "Heinonen teaches a permanent magnet (47) that is able to open a valve without residual magnetism *since it is a permanent magnet* (col. 5[,] lines 60[–]65, col. 6[,] lines 1[–]30)." Answer 4 (emphasis added). It is not apparent to us, however, that any of the cited portions of Heinonen teaches that magnet 47 attract a valve element toward an open position, and holds the valve element in the open position without electrical energy or residual magnetism caused by electrical energy. *See, e.g.*, Reply Br. 3–4. Further, to the extent that the Examiner's finding is that magnet 47 must operate to hold the valve element in an open position without electrical energy or residual magnetism caused by electrical energy because magnet 47 is a permanent magnet, we disagree with the Examiner's finding. The Examiner does not provide evidence

sufficient to establish, and it is otherwise not apparent to us, that every permanent magnet must operate to hold a valve element in an open position without electrical energy or residual magnetism caused by electrical energy. *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) ("Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."). Instead, it appears that Heinonen's arrangement may use "magnet 47 . . . to attract . . . valve plate 41 into a closed position . . . when electric current is supplied to actuator 46." Reply Br. 4 (emphasis omitted). Further, the Examiner does not establish that it would have been obvious to combine Phillips and Heinonen to provide an arrangement in which Heinonen's magnet (or some other permanent magnet) is placed in Phillips's device to magnetically attract a valve element toward an open position and hold the valve element in the open position without electrical energy or residual magnetism caused by the electrical energy, as claimed.

Thus, based on the foregoing, we do not sustain the rejection of independent claim 6. Further, we do not sustain any of the rejections of independent claims 8, 10, and 12, each of which recites a limitation similar to that discussed above for claim 6, and each of which the Examiner rejects for reasons similar to those discussed above. Still further, we do not sustain the rejections of claims 7, 9, 11, and 13 that depend from the independent claims, inasmuch as the Examiner does not establish that any other reference remedies the deficiency in the rejections of the independent claims.

DECISION

We REVERSE the Examiner's obviousness rejections of claims 6–13.

REVERSED